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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,080	09/19/2001	Kenji Yamaguchi	213672US2	9701

22850 7590 11/16/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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PIZARRO CRESPO, MARCOS D

ART UNIT	PAPER NUMBER
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2814

DATE MAILED: 11/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/955,080

**Applicant(s)**

YAMAGUCHI ET AL.

**Examiner**

Marcos D. Pizarro-Crespo

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 12-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-11, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-22 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11</u> . | 6) <input type="checkbox"/> Other: _____  |

Attorney's Docket Number: 213672US2

Filing Date: 9/19/2001

Claimed Foreign Priority Date: 5/19/2001 (JP P2001-138712)

Applicant(s): Kenji Yamaguchi, et al.

Examiner: Marcos D. Pizarro-Crespo

### **DETAILED ACTION**

This Office action responds to the amendment in paper no. 10 filed on 9/23/2004.

#### ***Acknowledgment***

1. The amendment in paper no. 10, filed on 9/23/2004, responding to the Office action in paper no. 9, mailed on 6/25/2004, has been entered. The present Office action is made with all the suggested amendments being fully considered. Accordingly, pending in this Office action are claims 1-20.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-11, 21, and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. § 103(a) as obvious over Yamaguchi (JP 2000-068508).

5. Regarding claims 7-11, 21, and 22, Yamaguchi shows (see, e.g., fig. 8) a semiconductor device evaluation apparatus 1 comprising:

- A calculation section 6
- A control section 4
- A first determination section 11 controlled by the control section 4
- A second determination section 13 controlled by the control section 4
- A third determination section 14 controlled by the control section 4

As to the grounds of rejection under section 103(a), the limitations in claims 7-11, 21, and 22, with respect to the manner in which the semiconductor device evaluation apparatus is intended to be used does not differentiate the claimed apparatus from that of Yamaguchi since Yamaguchi shows all the structural limitations recited in the claims. See MPEP § 2112 which discusses the handling of apparatus claims claimed in terms of function(s) and recommends the alternative (§ 102 / § 103) grounds of rejection. **Note that Applicant has burden of proof in such cases**, as the MPEP makes clear.

### ***Response to Arguments***

6. The applicants argue:

Yamaguchi fails to disclose a first determination section configured to determine a finished gate length, L<sub>g</sub>, as recited in the claims. He also fails to show a calculation section configured to plot an effective channel

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length,  $L_{eff}$ , and a gate capacitance,  $C_g$ , so as to calculate a gradient  $A$  of a gate capacitance vs. effective channel length characteristics, as recited in claim 7. Yamaguchi's calculation section also fails to plot a design gate length,  $L_d$ , and a gate capacitance,  $C_g$ , to calculate a gradient  $A$  of a gate capacitance vs. design gate length characteristics, as recited in claim 8. In other words, applicant's claimed invention does not calculate or determines an effective channel width,  $W_{eff}$ , as disclosed in Yamaguchi.

The examiner responds:

Applicants' arguments are mainly directed to functional aspects of the invention. However, the claims are directed to an apparatus not to its method of operation. A limitation in a claim with respect to the manner in which a claimed apparatus is intended to be used does not differentiate the claimed apparatus from the prior art if the prior-art apparatus teaches all structural limitations in the claims. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. App. & Inter. 1987). In other words, of course there are many ways of operating one's invention, however, operating it in a particular way does not differentiate it from the prior art. For instance, a car would be the same whether it is driven recklessly or carefully. How you drive the car does not change it in any way. The car would be the same regardless of how it was driven. In the instant case, and as explained above in paragraph 5, Yamaguchi shows all the structural limitations recited in the claims.

### **Conclusion**

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Papers related to this application may be submitted directly to Art Unit 2814 by facsimile transmission. Papers should be faxed to Art Unit 2814 via the Art Unit 2814 Fax Center. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The Art Unit 2814 Fax Center number is **(703) 872-9306**. The Art Unit 2814 Fax Center is to be used only for papers related to Art Unit 2814 applications.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Marcos D. Pizarro-Crespo** at **(571) 272-1716** and between the hours of 9:30 AM to 8:00 PM (Eastern Standard Time) Monday through Thursday or by e-mail via [Marcos.Pizarro@uspto.gov](mailto:Marcos.Pizarro@uspto.gov). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy, can be reached on (571) 272-1705.

11. Any inquiry of a general nature or relating to the status of this application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

12. The following list is the Examiner's field of search for the present Office Action:

Field of Search	Date
U.S. Class / Subclass(es): 324/71.1,658,661,662,671,716,719,765-769;257/48	6/17/04
Other Documentation: PLUS Analysis	6/17/04
Electronic Database(s): EAST (USPAT, EPO, JPO, PGPub)	6/17/04



LONG PHAM  
PRIMARY EXAMINER

**Marcos D. Pizarro-Crespo**

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Art Unit 2814

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